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| 10/054,485          | 01/22/2002  | Petri Heinonen       | 442-006266-US (C03) | 6523             |
| 2512                | 7590        | 06/08/2004           | EXAMINER            |                  |
| PERMAN & GREEN      |             |                      | GELIN, JEAN ALLAND  |                  |
| 425 POST ROAD       |             |                      | ART UNIT            | PAPER NUMBER     |
| FAIRFIELD, CT 06824 |             |                      | 2681                | 8                |

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                          |                  |
|------------------------------|--------------------------|------------------|
| <b>Office Action Summary</b> | Application No.          | Applicant(s)     |
|                              | 10/054,485               | HEINONEN ET AL.  |
|                              | Examiner<br>Jean A Gelin | Art Unit<br>2681 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 March 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-70 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-70 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. This is in response to Applicant's arguments filed on March 31, 2004, in which claims 15-65 are currently pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-26, 37-40, 43-55, 57, 58, 63, 66-68, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling in view of Thompson et al. (US 5,465,401).

Regarding to claims 15, 46, Schilling teaches a radio unit (i.e., mobile radio communication unit, fig. 6), comprising: a controller (fig. 6, item 204); at least one storage device (i.e., a memory 206 of fig. 6), said at least one memory or credit card for storing personal access number which can be user's identification (col. 6, lines 9-29); and an interface (reader 208 or writer 212) coupled to said controller (204), said interface being adapted for mechanically and electrically coupling to said at least one memory or credit card, said at least one memory being attachable to said interface (i.e., insertion slots to insert cards, col. 7, lines 10-34), wherein while said interface is mechanically and electrically coupled to said at least one memory or credit card, said

controller is electrically coupled to said at least one memory or credit card capable to transfer data via the interface (see fig. 6, col. 6, line 47 to col. 7, line 13).

Schilling does not specifically disclose said at least one memory or credit card for storing at least one application program and the application program is adapted to send messages to another application via the interface.

However, said at least memory or credit card which can be an SIM card, storing at least one application program is very well known in the art of communications as evidenced by Thompson. Thompson teaches that resident applications and programs are store in the communication device and other application programs are stored in an application module (col. 3, lines 25-65), and selected application modules 100 may provide software program for specific function (col. 14, lines 55-62); the interface (i.e., bus 64) provides means to transmit information between communication device 50 and application modules 100 (col. 9, lines 36-47). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to implement the application modules 100 of Thompson within the mobile radio unit of Schilling in order to upload or download various application modules used to provide applications for outside services such as Computer Serve Prodigy, Navigation Service and so on. Thus, providing a single communication device with many categories of applications.

Regarding to claims 16, 47, Thompson teaches the application program includes a payment application program (i.e., price list for customers and stock prices col. 18, line 66 to col. 19, line 15).

Regarding to claims 17, 48, Thompson teaches wherein the at least one storage device (i.e. application modules 100 contains numerous portions) to store certain types of information in different location includes a first storage device and a second storage device, wherein the first storage device stores the at least one application program and the second storage device stores the identification information (i.e., more than one application modules can be inserted into the phone corresponding to at least two storage devices, col. 9, lines 13-30, and col. 14, lines 45-62).

Regarding to claims 18, 49, Thompson teaches wherein the first, storage device is adapted for attachably coupling to said interface (i.e., bus 64) (i.e., inserting application module within the radio unit, col. 9, lines 13-30).

Regarding to claims 19, 50, 55, 58, Schilling teaches wherein the second storage device includes a smartcard (i.e., Subscriber Identity Module (SIM) card) that is adapted for attachably coupling to said interface (see fig. 6, i.e., a smartcard equivalent to a SIM may store additional information beyond identification information, col. 4, lines 9-41).

Regarding to claims 22, 53, Thompson teaches wherein said at least one application program is controllable for being activated to control operations of said controller (i.e., application modules 100 allow the user of the communication device to perform a wide range of communication, which should invoke the processor or controller, col. 9, lines 13-30).

Regarding to claim 23, Schilling teaches wherein said wireless user terminal is a mobile telephone (fig. 10).

Regarding to claims 24, 54, Schilling teaches wherein the at least one storage device is adapted for attachably coupling to said interface (col. 6, lines 22-52).

Regarding to claims 25, 63, Schilling further teaches a transceiver that is bidirectionally coupled to said controller and to an external communication network (fig. 6, item 202).

Regarding claim 26, all the limitations therein are the same as those discussed above with respect to claim 15, and hence are rejected for the same reasons of obviousness given above.

Regarding to claims 66, 70, Schilling in view of Thompson teaches all the limitation above. Thompson further teaches a communication device comprises a plurality of application modules and resident memory having the capability to exchange information is functionally equivalent to the limitation of the claim 66 (col. 9, lines 15-47 and col. 14, lines 45-62).

Regarding to claim 67, Schilling in view of Thompson teaches all the limitation above. Schilling further teaches first and second memory device includes a credit card (see fig. 6, i.e., a credit card is functionally equivalent to a debit card, col. 2, lines 33-38).

4. Claims 20, 45, 51, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling in view of Thompson et al. (US 5,465,401), further in view of Michaels (WO 94/30023).

Regarding to claims 20, 21, 45, 51, 52, and 57, Schilling in view of Thompson teaches all the limitations above, except wherein said at least one application program includes a cash card application program.

However, the preceding limitation is very well known in the art of communications. Michael teaches the SIM card (application module) could acquire the function of a credit card, a multi-service card and so on, page 10, lines 10-17. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the techniques of Michael within the system of Schilling in view of Thompson in order to dynamically update services in the card, which can require a different process to be run each time a service is accessed, and use the card as a standalone item.

Regarding to claim 37, Schilling teaches the limitations of the claim as follow: inserting the credit card within the radio unit to establish communication to another radio unit, and debit card has been debited with respect to time and displaying the credit amount (col. 7, line 48 to col. 8, line 65).

Regarding to claim 38, Schilling teaches wherein information indicating a balance of a user account is stored in a memory of the wireless wherein further steps are performed of: user terminal, and entering information into the wireless user terminal requesting that the information indicating the balance of the user account be retrieved (col. 7, lines 48-63); in response to the mobile radio communication unit receiving the entered information, retrieving the information indicating the balance of the user account

from the memory, and providing the information indicating the balance of the user account to a user (col. 7, line 47 to col. 8, line 54).

Regarding to claims 39, 40, Thompson inherently teaches wherein said at least one storage device (i.e. application modules can be inserted, which can be inherently removed) is a removable from said interface (col. 9, lines 13-30).

Regarding to claims 43-44, Schilling teaches wherein said identification information also identifies a telephone number of said mobile radio user (i.e., the telephone number follows the user on his debit card, col. 2, lines 36-40).

5. Claims 27-30, 34, 36, 35, 59, 60, 62, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling in view of Thompson further in view of Gutman et al.

Regarding to claim 27, Schilling in view of Thompson teaches all the limitations above, but they fail to specifically teach the step of registering a payment transaction with at least one of an external terminal and the at least one application program

However, registering a payment transaction with an external terminal over the wireless communication is very well known in the art of communications, as evidenced by Gutman. Gutman teaches a means for wireless transmitting a message including financial information relating to the balance for initiating the financial transaction, (typically, the system should recognize the device to provide service, col. 16, line 65 to col. 17, line 16, col. 19, lines 3-7). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the techniques

of Gutman within the system Schilling and Thompson in order for the electronic wallet to wirelessly communicate with the financial institution to modify an amount in an account balance, such as by transferring cash from one account balance to another account balance (col. 13, lines 10-25).

Regarding to claim 28, Schilling further teaches wherein prior to the performance of the registering step, further steps are performed of: entering information into the mobile radio user terminal (i.e., writing and rewriting the credit amount, col. 6, lines 53-68); and in response to the entering step, the mobile radio user terminal performs a step of: comparing the entered information to the identification information to determine if the entered information and the identification information are similar; and, if they are similar, the registering step is performed (col. 9, line 3 to col. 10, line 64).

Regarding to claim 29, Gutman in combination with Schilling and Michael teaches wherein the at least one electronic wallet has an associated account balance, and wherein the method further comprises a step of decreasing the associated account balance by an amount of said payment transaction (col. 13, lines 10-65).

Regarding to claim 30, Gutman teaches wherein prior to the performance of the decreasing step, further steps are performed of: receiving information representing the associated account balance from a network, and storing the received information representing the associated account balance in the wireless user terminal (i.e., inherent in col. 12, line 64 to col. 14, line 67).

Regarding to claim 34, Schilling teaches wherein the mobile radio user terminal has an associated account balance, and wherein prior to the registering step, further

steps are performed of: providing information representing a credit value from a credit source to the wireless user terminal, the credit value being at least as great as a value of said payment transaction (col. 8, lines 4-65); and increasing a value of the associated account balance by the credit value represented by the information provided to the wireless user terminal (col. 8, lines 4-15).

Regarding to claim 35, Schilling further teaches wherein after perform the step of registering is performed, a further step is of decreasing the value of the associated account balance by the value of said payment transaction (col. 8, lines 4-27).

Regarding to claim 36, Schilling in view of Thompson teaches all the limitations. Schilling further teaches steps of: entering information into the mobile communication unit specifying that a payment be made from the mobile communication unit to an external terminal (col. 9, lines 3-29); establishing a communication link between the mobile communication unit and the external terminal (i.e., radio unit links debit/credit card, col. 9, lines 24-64); verifying that an account associated with the credit card has at least a predetermined balance (col. 8, lines 4-44).

Schilling in view of Thompson fails to teach registering a payment transaction with at least one of the external terminal and the credit card.

However, registering a payment transaction with an external terminal over the wireless communication is very well known in the art of communications, as evidenced by Gutman. Gutman teaches a means for wireless transmitting a message including financial information relating to the balance for initiating the financial transaction, (typically, the system should recognize the device to provide service, col. 16, line 65 to

col. 17, line 16, col. 19, lines 3-7). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the techniques of Gutman within the system Schilling and Thompson in order for the electronic wallet to wirelessly communicate with the financial institution to modify an amount in an account balance, such as by transferring cash from one account balance to another account balance (col. 13, lines 10-25).

Regarding to claims 59, 60, 62, and 65, all the limitations have been discussed in claims 15 and 27 above except the steps of: transmit and receive data relating to the application program.

However, the preceding limitations are very well known in the art of communications, as evidenced by Gutman. Gutman the user of the electronic wallet may borrow cash from a credit account and may transfer cash from one account balance to another account balance. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the techniques of Gutman within the system Schilling and Michael in order to facilitate user to make transaction without being fixed to a particular location.

6. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schilling in view of Thompson further in view of Gutman, and further in view of Fujii et al. (GB 2,251,357 A).

Regarding to claim 31, Schilling, Thompson, and Gutman teach all the limitations above except wherein an external storage location stores information specifying a

transaction credit value for the wireless user terminal, and wherein the method further includes steps of: retrieving the information specifying the transaction credit value from the external storage location; and storing the retrieved information specifying the transaction credit value in the mobile radio user terminal.

However, the steps of: retrieving the information specifying the transaction credit value from the external storage location; and storing the retrieved information specifying the transaction credit value in the wireless user terminal are very well known in the art of communications, as evidenced by Fujii. Fujii teaches retrieving a plurality of subscriber information from the external device and transferring the retrieved information to the storage device of the radiotelephone so that content can be renewed (page 20, lines 7-13). The external device can be used as a memory (i.e. application modules which has the capability to contain diverse types of information such as list prices for customers, stock prices and so on disclosed by Thompson). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented the technique of Fujii within the system of Schilling, Gutman, and Thompson so that the radiotelephone unit and the external device can mutually rewrite the stored content of the storage units 36 and 46 from the other side respectively (page 21, lines 5-9).

Regarding to claim 32, Schilling further teaches wherein the external storage location is located within an external communication network (i.e., debit meter is coupled to base station, col. 9, lines 44-64).

Regarding to claim 33, Schilling teaches the claimed limitations except wherein the retrieving step includes communicating a Short Message Service (SMS) message from the wireless user terminal to the external storage location.

However, the use of Short Message Service (SMS) message is very well known in the art of communications. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have implemented Short Message Service (SMS) message to retrieve a single of subscriber information from an external device as a matter of user preference, given the equivalence in function.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 15-65 are rejected under the judicially created doctrine of double patenting over claims 1-22 of U. S. Patent No. 6,418,326 and claims 13-18, 22-24, and 26-37 of U. S. Patent No. 6,078,806 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a mobile radio communication unit, comprising: a controller; at least one storage device, said at least one storage device at least one application program and identification information, wherein the identification information identifies a user of said wireless user terminal; and an interface coupled to said controller, said interface being adapted for mechanically and electrically coupling to said at least one storage device, said at least one storage device being attachable to said interface, wherein while said interface is mechanically and electrically coupled to said at least one storage device, said controller is electrically coupled to said at least one storage device.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Allowable Subject Matter***

9. Claims 41, 42, 61, and 69 would be allowed if overcome the double patenting rejection.
10. Claims 56, 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if overcome the double patenting rejection.

11. The following is an examiner's statement of reasons for allowance: claims 41, 42, 56, 61, 64, and 69 are allowed for the same reason recited in the previous Office Action mailed on 9/29/03 (paper no. 6).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Response to Arguments***

12. Applicant's arguments filed 3/31/04 have been fully considered but they are not persuasive.

The Applicant argues that Schilling and Thompson fail to teach the feature "the application program is adapted to send messages to another application via the interface" as recited in claims 15, 26, 41, and 46. However, the Examiner disagrees with the preceding assertion; Thompson teaches application modules allow communication devices to offer users wide range of options concerning communications network and information (i.e., it is inherent that user can use adapt one application module in a communication device to transmit message to another application module, col. 9, lines 20-30). Thompson further teaches transmitting message between resident memory and application module; both resident memory and application module are read as application program (col. 9, lines 30-47), according to the Examiner, because both include rules to command each other to perform or execute certain functions.

The Applicant further argues that Thompson teaches the common bus provides sufficient capacity to transmit information between processor, resident memory, and application module. Given that Thompson teaches the exchange of information between resident memory and application module and given that both application module and resident memory are storage units, therefore the resident memory and application module can perform the function of application program and exchange information between them. Schilling and Thompson meet the limitations of claims 15, 26, and 46 as explained above. The rejection mailed on 9/29/03 is maintained.

Applicant further argues that claims 16-25, 27-40, 43-45, 47-55, 57-60, 62, 63, and 65 depend on claims 15, 26, and 46 respectively. These claims are patentable in view of their dependencies. However, claims 15, 26, and 46 are rejected as explained in the argument above. Therefore, the rejection of claims 16-25, 27-40, 43-45, 47-55, 57-60, 62, 63, and 65 are maintained for the same reasons as set forth in the rejection above.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A Gelin whose telephone number is (703) 305-4847. The examiner can normally be reached on 9:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEAN GELIN  
PATENT EXAMINER  
JGelin  
June 3, 2004 *Jean Allard Gelin*